

### **REMARKS**

This paper is filed in response to the Office Action mailed on March 8, 2007 and therefore no fee is due.

Claims 1-3 and 5-19 are pending; claims 7 and 15 are restricted; claims 1-3, 5-6, 8, 10-14, 16, 18 and 19 stand rejected; claims 9 and 17 are objected to but indicated as being allowable. In response, claims 1 and 14 have been amended and applicants respectfully submit that claim 1-3 and 5-19 are now allowable over the art of record.

### **Claim Amendments**

Claims 1 and 14 have been amended to make it clear that the plate-like light guide of light transmitting material extends laterally beyond the front plate and at least substantially parallel thereto and further engages the three dimensional body of light transmitting material *laterally beyond the front plate*. Support for these amendments appears at: page 1, lines 5-6 of the application as filed (the three-dimensional body being of a light transmitting material); claim 4 as originally filed (at least substantially parallel); and FIGS. 3 and 4 (the lateral extension of the plate-like structure beyond an edge of the front plate). Thus, no new matter is added thereby.

### **Claims 1 and 14 are not Anticipated by Kingston**

Claims 1, 3, 5, 8 and 13 stand rejected as allegedly being anticipated by Kingston (U.S. Pat. No. 3,968,584). Applicants respectfully submit that this rejection is improper for the following reasons. At the outset, under MPEP §2131,

"[t]o anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference "" Citing, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Kingston discloses an illuminated sign with four main components: (a) the primary member is a transparent light-source plate 5 having cavities 6 in its edges; (b) the second member is a plurality of electric light bulbs 7 seated in the cavities 6; (c) the third member is an opaque plate 12 having a character 13 that is superposed on the light-source plate 5; and (d) the fourth member is a frame 15 that is channel-shaped or U-shaped in cross section and which surrounds the two plates which are confined between the two plates (column 1, lines 38-56; claim 1). The frame 15 is not a light-transmitting member.

Kingston does not teach or suggest a plate-like a structure of light-transmitting material that extends parallel to and laterally beyond a front plate as recited in independent claims 1 and 14. The Kingston light-source plate 5 clearly does not extend laterally beyond an edge of the opaque plate 12 and does not engage a three-dimensional object of a light-transmitting material laterally beyond an edge of the opaque plate 12. Therefore, claims 1 and 14 cannot be anticipated by Kingston and the §102 rejection of claims 1-3, 5, 8 and 13 is improper under §2131 and must be withdrawn.

**Claims 1 and 14 are not obvious in view of Kingston or a combination of Kingston and Shelton or Green**

Claim 10 stands rejected as allegedly being obvious in view of Kingston. Applicants respectfully submit that none of the obviousness rejections establish a *prima facie* case of obviousness under MPEP § 2142, which requires:

"[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *Citing, In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

As indicated above, Kingston teaches that the character 13 is part of the opaque plate 12 which is arranged in front of the light-source plate 5 and that both plates 12 and 5 should be *surrounded by* and *confined in* a channel shaped frame 15. The frame 15 should provide the electrical connections to the lamps (*see* column 1, lines 56-58; claim 1).

Thus, Kingston not only does not teach or suggest, but actually teaches away from a light-source plate extending laterally beyond an edge of the front plate 12 for purposes of engaging a three-dimensional light-transmitting body *laterally beyond the front plate* as recited in claims 1 and 14. As the character portion 13 is a part of the front plate 12, Kingston teaches away from a three-dimensional light transmitting body being arranged laterally beyond the front plate as recited in independent claims 1 and 14, respectively.

Moreover, the characters 13 in the Kingston sign do not, and indeed cannot, appear to float or to be self-supported as provided by the signs of claims 1 and 14, as Kingston stipulates the presence of features (characters on opaque plate, frame surrounding the edges of the plates) that inherently preclude achieving any sense of floating or being self-supported as provided in the present application. As a result, one skilled in the art wanting to create a floating design type illuminated sign would not look to Kingston for guidance.

Therefore, independent claim 1 is clearly allowable over Kingston as Kingston fails to teach or suggest every element of claim 1 and Kingston fails to suggest any modifications to its disclosure which would result in the sign of claim 1. Therefore, dependent claim 10 is allowable over Kingston.

Claims 6, 14, 16, 18 and 19 stand rejected as allegedly being obvious in view of Kingston and Shelton (U.S. Pat. No. 5,536,558). Shelton is merely cited for the proposition that it discloses a light guide 12 with bevelled edges or end surfaces that engage a three dimensional body. As pointed out in the response, dated March 13, 2006,

to the final Office Action, dated October 19, 2005, Shelton teaches such bevelled edges to form a box construction, thus connecting essentially two-dimensional objects. Moreover, when constructing a box, the bevelled edges must naturally point inward, *i.e.*, the bevelled edge and thus the position of engagement, does not lie laterally *beyond*, but rather *within* an edge of the front plate. It is therefore submitted that also Shelton teaches away from an illuminated sign according to claims 1 and 14 because the concept of a plate-like light guide extending laterally beyond a front plate before it engages a three-dimensional light-transmitting body is totally missing from Shelton.

No combination of Kingston and Shelton teaches or suggest a plate-like light-transmitting member that extends laterally beyond a front plate to engage a three-dimensional light-transmitting body to create the floating appearance of the sign claimed in independent claims 1 and 14. Because independent claims 1 and 14 are clearly allowable over any hypothetical combination of Kingston and Shelton, Applicants respectfully submit that dependent claims 6, 16, 18 and 19 are allowable over these two references as well.

Finally, claims 11 and 12 stand rejected as allegedly being obvious in view of Kingston and Green (U.S. Pat. No. 3,751,319). However, Green merely decided for the proposition that it discloses a hardening resin on a surface of the display. Thus, the arguments in the above-referenced response, dated March 13, 2006, to the final Office Action, dated October 19, 2005, remain valid. Green teaches nothing about an illuminated sign with a front plate, a plate-like light guide that extends laterally beyond the front plate and a three dimensional body connected to the light guide laterally beyond the front plate to create a floating appearance. Thus, Green cannot supplement the deficiencies of Kingston and Shelton as explained above.

Accordingly, independent claim 1 is clearly allowable over Kingston and Green and therefore dependent claims 11 and 12 are clearly allowable over Kingston and Green and the obviousness rejection of claims 11 and 12 is improper must be withdrawn.

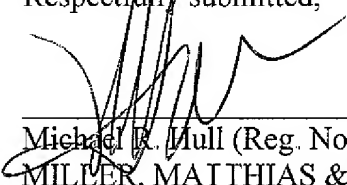
In view of the above, claims 1 and 14 are clearly allowable over any hypothetical combination of Kingston and Green or Kingston, Shelton and Green and consequently dependent claims 2-3, 5-13 and 15-19 are allowable as well.

In early action indicating the allowability of claims 1-3 and 5-19 is respectfully requested.

Respectfully submitted,

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